

REMARKS

The last Office Action has been carefully considered.

It is noted that Claims 1-8 are rejected under 35 USC 103 over the U.S. patent to Dürr in view of the patent to Smith.

Claims 9-10 are rejected under 35 USC 103 over the patent to Dürr in view of the patent to Walton.

Claims 1-4 are rejected under 35 USC 103(a) over the U.S. patent to Clowers in view of the patent to Smith.

After carefully considering the Examiner's grounds for rejection of the claims over the art, applicant amended Claim 1, the broadest claim on file, so as to more clearly define the present invention and to distinguish it from the prior art.

Claim 1 as amended, in addition to other features, defines a spring element as means for automatically adjusting the oscillation stroke smoothly between the maximum and minimum stroke during the sawing process, as an

automated response to a function of the pressure of the saw blade against a work piece to be sawn.

It is respectfully submitted that the present invention does not have automatic means for adjusting the oscillation stroke during the sawing process as an automatic response to a function of the pressure of the saw blade against the work piece to be sawn, but means for automatically adjusting the oscillation stroke as an automatic response to a function of the pressure of the saw blade against a work piece to be sawn.

The Examiner indicated that to provide automatic means to replace manual activity which has accomplished the same results can be considered as an obvious modification. However, in the present case this cannot be considered as an obvious modification since the motor-driven compressed saw machine is designed to provide the above mentioned means for automatically adjusting the oscillation stroke as an automatic response to a function of the pressure of the saw blade against the work piece to be sawn, it has a simpler construction, it operates more efficiently, it works more accurately, and provides for a higher yield. Therefore, the above mentioned distinctive feature of the present invention cannot be considered as an obvious modification of the invention disclosed in the patent to Dürr.

The patent to Smith, as stated by the Examiner on page 5, described a sensing device for measurement and calculation of the movement and lateral displacement of the saw blade, and in the Examiner's opinion these measurements can be used to automatically alter the work-feed rate and/or saw blade rim speed as sawing conditions change within the work piece. In the motor-driven compass saw machine in accordance with the present invention, there is no such sensing device for measurement and calculation of the movement of the saw blade. In contrast, the saw machine in accordance with the present invention is provided with means for automatically adjusting the oscillation stroke, that comprise a spring element which is able to automatically adjust the oscillation stroke.

Claim 1 cannot be considered as obvious over the U.S. patents to Dürr and Smith, because according to Claim 1 as amended there is no sensing means for measuring and calculating the movement of the saw blade. The patent to Smith does not disclose a spring element for automatically adjusting the oscillation stroke of the saw blade. Therefore, it is believed to be clear that a combination of the teachings of the patent to Dürr and Smith would not lead a person skilled in the art to the present invention as defined in amended Claim 1.

On page 6 of the Office Action the Examiner stated that the patent to Dürr discloses a spring element as part of the oscillation mechanism. The

Examiner referred to the spring element shown in Figure 1 to the left of reference 16. Applicant has to respectfully disagree with the Examiner's position. The function of this spring is not described in the patent to Dürr. Throughout the disclosure the patent to Dürr discloses the reciprocating mechanism in detail, and in the description of the reciprocating mechanism the spring shown in Figure 1 does not play any role. Therefore, it is not correct that the Examiner attaches this function to the spring from a mere consideration of Figure 1. In addition, the spring is not shown in Figures 2-5. Figures 2-5 show how the pivoting fork can be designed such that the reciprocating stroke can be adjusted step-by-step or continuously as explained in column 4, lines 5-7. Since the spring is not shown in Figures 2-5, a person of ordinary skill in the art can only conclude that the spring does not play any roll in the reciprocating stroke mechanism disclosed in the patent to Dürr. Therefore, the oscillating mechanism including a spring element as defined in amended Claim 1 cannot be considered as obvious from the patent to Dürr.

Claim 1 is further rejected as being unpatentable over the U.S. patent to Clowers in view of the patent to Smith. The Examiner acknowledged that the patent to Clowers did not disclose the oscillating mechanism including automatic means for adjusting the oscillation stroke smoothly between the maximum and minimum stroke during the sawing process, as an automatic

response to a function of the pressure of the saw blade against a work piece to be sawn.

As for the patent to Smith, this reference has been analyzed hereinabove, and it is clear that it does not teach the new features of the present invention.

On page 11 of the Office Action the Examiner indicated that in his opinion Clowers disclosed a spring element (60) as a part of the oscillation mechanism. The spring (60) according to the patent to Clowers is not a means for automatically adjusting the oscillation stroke smoothly between the maximum and minimum stroke during the sawing process, as an automatic response to a function of the pressure of the saw blade against the work piece to be sawn, such that the spring element is compressed further as the pressure of the saw blade against the work piece to be sawn increases and a larger oscillation is produced.

As explained in column 4, lines 8-28, the spring (60) hooks beneath the orbit cam lever and forces the cam following face (56) to press against the orbit cam (28). There is an orbit control knob (68) which may be operated manually by the operator of the saw as shown in Figure 3. The rotation of the knob (68) and the shaft (66) moves the pivot pin (64). This movement of the

pivot pin changes the pivot point (54) of the orbit cam lever (52) from a first position, with no orbital motion imparted to the saw blade, to a second position, with substantial orbital motion imparted to the saw blade. From Figure 3 and the disclosure it is clear that the patent to Clowers does not disclose an oscillation mechanism including a spring as means for automatically adjusting the oscillation stroke smoothly between the maximum and minimum stroke during the sawing process, as an automatic response to a function of the pressure of the saw blade against a work piece to be sawn.

In view of the above presented remarks and amendments, it is believed to be clear that the patents to Dürr, Smith and Clowers did not disclose the new features of the present invention as defined in amended Claim 1. These references also do not provide any hint, suggestion or motivation for these features, either taken singly or in combination with one another.

The present invention cannot be considered as obvious from the references. A person of ordinary skill in the art, in order to arrive at the present invention as defined in amended Claim 1, should have modified the invention as disclosed in the references by including into them the new features of the present invention which were first proposed by the applicant. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision *In Re Randol and Redford* (165 USPQ 586) that:

Prior patents are references only for what they clearly disclose or suggest, it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

In view of the above presented remarks and amendments it is believed that Claim 1 as amended should be considered as patentably distinguishing over the art and should be allowed.

As for the dependent claims, these claims depend on Claim 1, they share its presumably allowable features, and they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should

the Examiner feel that a personal discussion might be helpful in advancing this case to allowance; he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,



Michael J. Striker
Attorney for Applicant
Reg. No. 27233